Appl. No. 10/632,987
Amdt. Dated 11/13/2007
Response to Office action dated 6/12/2007

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REMARKS

Claims 5, 6, 7 and 17-26 have been amended. Claims 1-4 and 27-36 have been canceled. No new claims have been added and no new matter has been added. Claims 5-26 are pending.

The claim amendments are supported in the specification at paragraphs 31-36.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 5, 6, 7 and 17-26 have been amended, and claims 1-4 and 27-36 have been canceled, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 5, 6, 7 and 17-26 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Specification

The Examiner objected to paragraph 23 stating that the phrase "image forming apparatuses" should be changed to "information processing apparatuses". The specification has been amended as per the Examiner's suggestion and therefore this objection is moot. Accordingly, it is respectfully requested that the objection be withdrawn.

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Claim Objections

The Examiner objected to claims. This objection is respectfully traversed. The Examiner pointed to the following informalities:

- Claim 3, line 9: the word "form" should be changed to "from". This objection is moot as claim 3 has been canceled.

- Claim 5, line 2: the phrase "on the instructions" should be changed to "on instructions". Claim 5 has been amended as per the Examiner's suggestion. As such, it is respectfully requested that this objection be withdrawn.

- Claim 6, line 15: the phrase "specified image forming apparatus" should be changed to "a specified image forming apparatus". Claim 6 has been amended to include "a specified image forming apparatus". It is respectfully requested that this objection should be withdrawn as there is antecedent basis for "the specified image forming apparatus".

- Claim 6, line 21: the phrase "the operator" should be changed to "an operator". Claim 6 has been amended as per the Examiner's suggestion. As such, it is respectfully requested that this objection be withdrawn.

- Claim 12, line 14: the phrase "the respective different image forming apparatus" should be changed to "a respective different image forming apparatus". Claim 12 has been amended to refer to "the different image forming apparatus". It is respectfully requested that this objection should be withdrawn as there is antecedent basis for "the different image forming apparatus".

- Claim 22, line 3: the phrase "the respective different image forming apparatus" should be changed to "a respective different image forming apparatus". Claim 22 has

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been amended to refer to "the different image forming apparatus". It is respectfully requested that this objection should be withdrawn as there is antecedent basis for "the different image forming apparatus".

Claim Rejections - 35 USC § 101

The Examiner rejected claims 17-26 under 35 USC § 101 as directed to non-statutory subject matter. Claim 17 has been amended as per the Examiner's suggestion. As such, it is respectfully submitted that claims 17-26 are now directed to statutory subject matter and this rejection should be withdrawn.

Claim Rejections - 35 USC § 112

The Examiner rejected claim 6 under 35 USC § 112, second paragraph as indefinite. Claim 6 has been amended to the limitation, "sends print information from the information processing apparatus to the *image forming apparatus* when it determines recording is available". It is respectfully submitted that the § 112, second paragraph rejection is moot as the claim now disclosing sending the print information from the information processing apparatus to the image forming apparatus.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 1-5 under 35 USC § 102(b) as anticipated by Geelen (US Pub 2002/0054322). This rejection is moot with respect to claims 1-4 as claims 1-4 have been canceled. This rejection is respectfully traversed with respect to claim 5.

Claim 5 recites at least three limitations not disclosed by Geelen. Claim 5 recites, "receiving requests for information on recording paper from an information processing apparatus", "transmitting information on recording paper that includes at least information on sizes of recording paper that is available for image forming corresponding to the requests for information from the information processing apparatus" and "receiving and executing print instructions from the

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aforementioned information processing apparatus after transmitting the aforementioned information on recording paper". Paragraph 35 of the published application discloses:

> "FIG. 3 is a flow chart that shows a print processing routine in accordance with the invention. The information processing apparatus transmits a pseudo print instruction (step S110). When the pseudo print instruction is transmitted, the image forming apparatus becomes selectable (step S120). When the image forming apparatus is selected, a signal to request the available paper is transmitted to the selected image forming apparatus (step S130). When the image forming apparatus receives the request for paper information, the image forming apparatus sends the requested information to the information processing apparatus that requested the information. The information from the image forming apparatus is received and analyzed, and the information on the available paper may be displayed by the information processing apparatus (step S140)."

Paragraph 39 of the published application further discloses:

> "when the specified paper is available in step S150, the information processing apparatus transmits a print instruction (step S190), and the print data is transmitted from the information processing apparatus to the image forming apparatus (step S200)."

As disclosed above, claim 5 recites "receiving requests for information on recording paper from an information processing apparatus", "transmitting information on recording paper that includes at least information on sizes of recording paper that is available for image forming corresponding to the requests for information from the information processing apparatus" and "receiving and executing print instructions from the aforementioned information processing apparatus **after transmitting the aforementioned information on recording paper**".

Geelen discloses a method for notifying a user when the type of sheets needed for the user's print job are not available in the printer. (Geelen, [0034]-[0054]). Specifically, Geelen discloses a system whereby a printer (or multiple printers) is connected to multiple user terminals. A user requests a print job and the printer is examined to "identify the type or types of recording sheet that

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are needed for this job". (Geelen, [0038]). If all of the sheets required for the print job are available, then the print job is processed immediately. If however, some of the sheet types are not available, then the user receives a message on his terminal requesting the user to load a certain tray with the proper paper. (Geelen, [0041]). After the user receives this message, the user has a predetermined amount of time to respond to the requested action and fix the error. If the user does not respond in the predetermined amount of time, then the "key operator" is notified of the message so the key operator may fix the error. (Geelen, [0045]). Therefore, Geelen discloses a method whereby a user is informed when the printer does not have the necessary sheet types needed for the requested print job. Instead of notifying everyone on the network, that specific user is notified in order to fill the printer with the proper paper type.

However, Geelen nowhere discloses, "receiving and executing print instructions from the aforementioned information processing apparatus **after transmitting the aforementioned information on recording paper**". Geelen discloses receiving a print job and if the printer cannot handle the print job as requested, then it notifies the user with a message informing the user to fix a problem so that the print job can continue as requested. In other words, in Geelen, a user requests a print job **and then** it is determined whether the printer has the necessary paper sheets for the print job. However, in claim 5, the printer receives "requests for information on recording paper from an information processing apparatus" before the print instructions are sent to the printer. That is, Geelen nowhere discloses "transmitting information on recording paper that includes at least information on sizes of recording paper that is available for image forming corresponding to the requests for information from the information processing apparatus" and "receiving and executing print instructions from the aforementioned information processing apparatus **after transmitting the aforementioned information on recording paper**" as disclosed in claim 5. Informing the user of an issue with the print job is not the same as "receiving and executing print instructions from the aforementioned information processing apparatus **after transmitting the aforementioned information on recording paper**" as disclosed in claim 5. As such, Geelen does not disclose all of

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the limitations of claim 5. Accordingly, it is respectfully requested that the 102(b) rejection of claim 5 be withdrawn.

Claim Rejections - 35 USC § 102

The Examiner rejected claim 6 under 35 USC § 102(b) as anticipated by Sumiyama (US Pub 2002/0036799). This rejection is respectfully traversed.

Claim 6 recites at least two limitations not disclosed by Sumiyama. Claim 6 recites, "transmitting print instructions from an information processing apparatus to a specified image forming apparatus" and "for every print job request, requesting information on recording paper from the specified image forming apparatus corresponding to the transmitted print instruction". The Office action asserts that this limitation is taught by Sumiyama at [0026]-[0034].

Sumiyama is directed to identifying a printer that best matches the image size requirements of the print job. Specifically, Sumiyama discloses first determining the "size information details regarding all images". (Sumiyama, [0033]). Then, Sumiyama discloses determining "whether or not all of the image size information in the job data matches the sizes available in the printers" and then "a printer is selected that holds the paper of the sizes that correspond to the image size information for the entire job". (Sumiyama, [0033]). Sumiyama further discloses that "[w]here the image size information for the entire job does not match the sizes available in the printers in step S33, a printer that has the most paper sizes that match the image sizes in the job data is selected." (Sumiyama, [0034]). Therefore, Sumiyama discloses a method of selecting a printer that best matches the image size requirements for a print job.

However, Sumiyama nowhere discloses, "for every print job request, requesting information on recording paper from the specified image forming apparatus **corresponding to the transmitted print instruction**". The Office action asserts that Sumiyama teaches that "a server requests information regarding the sizes of the papers inside multiple printers, since multiple printers in the system that are specified by the network respond to the transmitted print job in the server". (Office action, page 11). However, Sumiyama's teaching of using a server to

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determine the paper inside multiple printers is not the same as "requesting information on recording paper from the specified image forming apparatus **corresponding to the transmitted print instruction**" as disclosed in claim 6. This is not the same because in Sumiyama, a server stores the information regarding the paper in the printers and the server queries its own memory to determine what paper exists in each printer. However, Sumiyama does not disclose "requesting information on recording paper from the specified image forming apparatus **corresponding to the transmitted print instruction**". Specifically, Sumiyama does not disclose "transmitting print instructions from an information processing apparatus to a specified image forming apparatus" and then "requesting information on recording paper from the specified image forming apparatus **corresponding to the transmitted print instruction**" as disclosed in claim 6. As such, it is respectfully requested that the 102(b) rejection of claim 6 be withdrawn because Sumiyama does not disclose all of the limitations of claim 6.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 7-26 under 35 USC § 103(a) as obvious from Geelen et al. in view of Yacoub '813 (US Pat 6552813). This rejection is respectfully traversed.

Yacoub is directed a "virtual printer" which allows a user to set certain preferences for his print job (such as image quality and speed). Based on the user's setting, the virtual printer can determine which of the networked printers best meet the user's print job preferences.

Claim 7 recites, "transmitting print instructions to the specified image forming apparatus **after receiving an information on recording paper from the specified image forming apparatus**". Yacoub nowhere discloses this limitation. Yacoub discloses using a "virtual printer" to determine which printer can best handle the user's print job based on preset settings. That is, while Yacoub discloses a method to minimize user interaction by using a "virtual printer" that stores a user's print job preferences, Yacoub does not disclose "transmitting print instructions... *after* receiving an information on recording paper from the specified image forming apparatus". Because

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Yacoub does not disclose all of the limitations of claim 7, claim 7 is patentable over Yacoub. Accordingly, it is respectfully requested that the 103(a) rejection of claim 7 be withdrawn.

Claims 8-16 are dependent claims which depend on claim 7. By virtue of their dependency on claim 7, claims 8-16 are patentable over Yacoub for the same reason claim 7 is patentable over Yacoub. Accordingly, it is respectfully requested that the 103(a) rejection of claims 8-16 be withdrawn.

Claims 17-26 are similar to the method claims of claims 7-16 but claims 17-26 are directed to a computer usable medium. However, claim 17 includes a similar limitation claim 7, namely "transmitting print instructions to the specified image forming apparatus after receiving an information on recording paper from the specified image forming apparatus". As argued above regarding claim 7, Yacoub does not disclose, teach or suggest this limitation. As such, claim 17 is patentable over Yacoub because Yacoub does not disclose all of the limitations of claim 17. Further, by virtue of their dependency on claim 17, claims 18-26 are patentable over Yacoub. Accordingly, it is respectfully requested that the 103(a) rejection of claims 17-26 be withdrawn.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 27-30 and 32-35 under 35 USC § 103(a) as obvious from Yacoub in view of Geelen. This rejection is moot as these claims have been canceled.

The Examiner rejected claims 31 and 36 under 35 USC § 103(a) as obvious from Yacoub in view of Geelen and Sommer '244 (US 7158244). This rejection is moot as these claims have been canceled.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

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In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned registered practitioner to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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